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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,199	03/27/2001	Wei Shao	CL001187	9285

7590 05/11/2004  
CELERA GENOMICS CORPORATION  
45 West Gude Dr. C2#20  
Rockville, MD 20850

EXAMINER

RAWLINGS, STEPHEN L

ART UNIT PAPER NUMBER

1642

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/817,199

**Applicant(s)**

SHAO ET AL.

**Examiner**

Stephen L. Rawlings, Ph.D.

**Art Unit**

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003 and 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4,8,9 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 and 29 is/are allowed.
- 6) ☒ Claim(s) 4, 8, 9, 24, 26--28, 30, and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: USPTO Search Report, pp. 1-2.

### **DETAILED ACTION**

1. The amendment filed November 25, 2003 is acknowledged and has been entered.
2. The supplemental amendment filed February 23, 2004 is acknowledged and has been entered. Claim 4 has been amended. Claims 30 and 31 have been added.
3. Claims 4, 8, 9, and 24-31 are pending in the application and are currently under prosecution.

### ***Ground of Rejection Withdrawn***

4. The ground of rejection set forth in the previous Office action mailed August 25, 2003 has been withdrawn.

### ***Claim Objections***

5. Claims 24 and 27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 24 and 27 broaden the scope of the claims from which they depend. Presently claim 24, which depends from claim 9, recites, "a polypeptide comprising the amino acid sequence of SEQ ID NO:2"; and claim 9 is drawn to a host cell containing the vector of claim 8. Claim 27, which depends from claim 8, recites, "a polypeptide comprising SEQ ID NO:2". Claim 8 is drawn to a vector comprising the nucleic acid molecule of claim 4. Claim 4, however, is limited to a nucleic acid molecule consisting of a nucleotide sequence encoding a polypeptide consisting of SEQ ID NO: 2, SEQ ID NO: 1, SEQ ID NO: 3, or the full complement of a nucleic acid molecule consisting of a nucleotide sequence encoding a polypeptide consisting of SEQ ID NO: 2, SEQ ID NO: 1, or SEQ ID NO: 3; accordingly, the nucleic acid molecule of claim 4 can only encode a polypeptide consisting of the amino acid sequence of SEQ ID NO: 2. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 4, 8, 9, 24, 26-28, 30, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,569,662 B1, as evidenced by the attached USPTO Search Report “us-09-817-199c-2.rge”, Result No. 1.

As evidenced by the USPTO Search Report “us-09-817-199c-2.rge” (Result No. 1), US Patent No. 6,569,662 B1 (‘662) teaches the polynucleotide sequence of an isolated nucleic acid molecule encoding a polypeptide consisting of the amino acid sequence set forth in SEQ ID NO: 2, a vector comprising said polynucleotide sequence, a host cell comprising said vector, and a method for producing said polypeptide comprising culturing said host cell under conditions appropriate to produce the polypeptide and recovering the polypeptide; see, e.g., SEQ ID NO: 959 of the sequence listing; columns 171 and 172, Table 2; and column 3, lines 49-58. ‘662 teaches the vector can be a viral vector or a plasmid or phage; see, e.g., column 9, line 54, through column 10, line 18. ‘662 teaches the vector can comprise an operatively linked promoter; see, e.g., column 9, line 54, through column 10, line 18. ‘62 teaches the polynucleotide sequence can be joined to heterologous polynucleotide sequence encoding a heterologous amino acid sequence; see, e.g., column 15, lines 3-10; and column 14, lines 49-53.

***Conclusion***

8. Claims 4, 8, 9, 24, and 26-31 are rejected. Claims 25 and 29 are allowable.

Art Unit: 1642

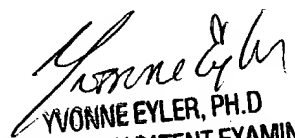
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler, Ph.D. can be reached on (571) 272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen L. Rawlings, Ph.D.  
Examiner  
Art Unit 1642

slr  
April 21, 2004

  
YVONNE EYLER, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

GenCore version 5.1.6  
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OM protein - nucleic search, using frame\_plus\_p2n model

Run on: March 19, 2004, 18:08:08 ; Search time 3729 Seconds  
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Listing first 45 summaries

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10: gb\_pl:\*  
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12: gb\_stc:\*  
13: gb\_un:\*  
14: gb\_un:\*  
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16: gb\_vt:\*  
17: em\_hum:\*  
18: em\_hum:\*  
19: em\_mu:\*  
20: em\_mu:\*  
21: em\_or:\*  
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## SUMMARIES

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3	1150	100.0	1977	6 AX835179	AX835179 Sequence
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5	1150	100.0	2612	6 AR220901	AR220901 Sequence
6	1145	99.6	1116	6 AX236082	AX236082 Sequence
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8	1081	94.0	2216	10 BC050757	BC050757 Mus muscu
9	1004	87.3	842	6 AR403539	AR403539 Sequence
10	1004	87.3	842	6 BD137355	BD137355 Opening s
11	977	85.0	576	6 AX236084	AX236084 Sequence
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13	942	81.9	576	6 BD103203	BD103203 Factors i
14	913	79.4	1745	6 BC040547	BC040547 Homo sapi
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17	787	68.4	968	6 AX823552	AX823552 Sequence
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25	710.5	61.8	3105	9 AK054846	AK054846 Homo sapi
26	649.5	56.5	2536	3 AY061826	AY061826 Drosophi
27	525.5	45.7	1002	8 AK111912	AK111912 Oryza sat
28	525.5	45.7	1022	8 AK112029	AK112029 Oryza sat
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34	516	44.9	765	5 DY00RA2	M38391 Discopoge o
35	516	44.9	911	8 AY084345	AY084345 Arabidops
36	516	44.9	2048	9 BC002977	BC002977 Homo sapi
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38	514.5	44.7	4749	10 BC059208	BC059208 Mus muscu
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44	513.5	44.7	760	4 CRRAB8	X56385 Canine rab8
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RESULT 1

## ALIGNMENTS

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 ORGANISM Unknown.  
 REFERENCE 1 (bases 1 to 1106)  
 AUTHORS Tang, Y.T., Zhou, P. and Dmanac, R.T.  
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 JOURNAL Patent: US 6569662-A 959 27-MAY-2003;  
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US-09-817-199C-2 (1-223) x AR339468 (1-1106)

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 Mammalia; Eutheria; Primates; Catarrhini; Homnidae; Homo.

REFERENCE  
 AUTHORS Strausberg, R.L., Feingold, E.A., Grouse, L.H., Derge, J.G.,  
 1 (bases 1 to 1700)  
 Strausberg, R.L., Collins, F.S., Wagner, L., Shenmen, C.M., Schuler, G.D.,  
 Klausner, R.D., Collins, F.S., Wagner, L., Shenmen, C.M., Schuler, G.D.,  
 Altschul, S.F., Zeeberg, B., Buetow, K.H., Schaefer, C.F., Bhat, N.K.,  
 Hopkins, R.F., Jordan, H., Moore, T., Max, S.I., Wang, J., Hsieh, F.,  
 Diatchenko, L., Marusina, K., Farmer, A.A., Rubin, G.M., Hong, L.,  
 Stapleton, M., Soares, M.B., Bonaldo, M.F., Casavant, T.L.,  
 Scheetz, T.E., Brownstein, M.J., Usdin, T.B., Toshiyuki, S.,  
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 Abramson, R.D., Mullahy, S.J., Bosak, S.A., McEwan, P.J.,  
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 Fahey, J., Helton, E., Kettman, M., Madan, A., Rodriguez, S.,  
 Sanchez, A., Whitting, M., Madan, A., Young, A.C., Shevchenko, Y.,  
 Bouffard, G.G., Blakeley, R.W., Touchman, J.W., Green, E.D.,  
 Dickson, M.C., Rodriguez, A.C., Grimwood, J., Schmutz, J., Myers, R.M.,  
 Butlerfield, Y.S., Krzywinski, M.I., Skalska, U., Smalins, D.E.,  
 Scherch, A., Schein, J.E., Jones, S.J., and Marra, M.A.  
 Generation and initial analysis of more than 15,000 full-length  
 human and mouse cDNA sequences  
 Proc. Natl. Acad. Sci. U.S.A. 99 (26), 16899-16903 (2002)  
 MEDLINE 22388257  
 PUBMED 12477932

REFERENCE  
 2 (bases 1 to 1700)  
 Strausberg, R.  
 Direct Submission  
 Submitted (31-OCT-2001) National Institutes of Health, Mammalian  
 Gene Collection (MGC), Cancer Genomics Office, National Cancer  
 Institute, 31 Center Drive, Room 11A03, Bethesda, MD 20892-2590,  
 USA

REMARK  
 NIH-MGC Project URL: <http://mgc.nci.nih.gov>  
 Contact: MGC help desk  
 Email: [cgabbs-remail.nih.gov](mailto:cgabbs-remail.nih.gov)  
 Tissue Procurement: DCTD/DTF  
 CDNA Library Preparation: Life Technologies, Inc.  
 CDNA Library Arrayed by: The I.M.A.G.E. Consortium (LNL)  
 DNA Sequencing by: Baylor College of Medicine Human Genome  
 Sequencing Center  
 Center code: BCM-HGSC  
 Web site: <http://www.hgsc.bcm.tmc.edu/cdna/>  
 Contact: [amg@bcm.tmc.edu](mailto:amg@bcm.tmc.edu)  
 Gunaratne, P.H., Garcia, A.M., Lu, X., Hulik, S.W., Louieged, H.,  
 Kowis, C.R., Sneed, A.J., Martin, R.G., Muzny, D.M., Nanavati,  
 A.N., Gibbs, R.A.

FEATURES  
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